



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,152	12/31/2001	Mian-Ying Wang	10209.383	3964

21999 7590 09/29/2003

KIRTON AND MCCONKIE  
1800 EAGLE GATE TOWER  
60 EAST SOUTH TEMPLE  
P O BOX 45120  
SALT LAKE CITY, UT 84145-0120

EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
----------	--------------

1654

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/036,152

Applicant(s)

WANG ET AL.

Examiner

Susan Coe

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed July 14, 2003, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 33 have been added.
3. Claims 1-33 are pending.

#### ***Claim Rejections - 35 USC § 112***

4. Claims 1-22, 27, 28, and 31-33 rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the specification is enabled for preventing the claimed conditions because the specification shows that the *Morinda citrifolia* composition is able to treat and prevent liver damage caused by carbon tetrachloride. However, carbon tetrachloride is only one potential cause of liver damage and cancer. Thus, while the specification is enabled for preventing liver damage and cancer caused by carbon tetrachloride, it is not enabled for preventing damage caused from other sources such as alcohol and disease. Therefore, the full scope of the claims is not considered to be enabled.

#### ***Claim Rejections - 35 USC § 103***

5. Claims 1-22 and 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Pat. Appl. No. 08217686 A for the reasons set forth in the previous Office action.

Art Unit: 1654

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference does not teach the claimed invention because it does not teach that "its composition cures all causes of cancer where many potential causes exist." However, the reference teaches that *M. citrifolia* is able to treat and prevent liver cancer by *H. pylori*. This is encompassed by applicant's broadly claimed invention. Therefore, it is considered to teach using *M. citrifolia* to treat and prevent liver cancer.

In addition, applicant argues that there is no motivation to administer the composition as claimed because the amounts claimed as needed for the treatment and prevention of carbon tetrachloride induced damage. However, applicant is not only claiming carbon tetrachloride damage. In addition, the claim directed specifically towards carbon tetrachloride is not included in this rejection. Furthermore, the amounts administered by applicant are amounts that would reasonably be arrived at by a person of ordinary skill in the art during a routine optimization of the disclosure of the reference.

6. Claims 1-22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 88/05304 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference does not teach how the composition is able to treat hepatitis and AIDS. However, even without an explanation of the specific mechanism of action the reference is still considered to be enabled because it teaches how to prepare and administer the *M. citrifolia* in order to effectively treat the disease states.

In addition, applicant argues that the reference administers ingredients in addition to the *M. citrifolia* and does not specifically teach that the *M. citrifolia* is the primary active ingredient.

Art Unit: 1654

However, applicant's claims use the transitional phrase "comprising." "Comprising" is considered to be open language which allows for the addition of any other ingredients. See MPEP section 2111.03. Thus, the composition used in the reference is the same as the claimed composition even if the reference does not specifically teach that *M. citrifolia* is the primary active ingredient.

In addition, applicant argues that there is no motivation to administer the composition as claimed because the amounts claimed as needed for the treatment and prevention of carbon tetrachloride induced damage. However, applicant is not only claiming carbon tetrachloride damage. In addition, the claim directed specifically towards carbon tetrachloride is not included in this rejection. Furthermore, the amounts administered by applicant are amounts that would reasonably be arrived at by a person of ordinary skill in the art during a routine optimization of the disclosure of the reference.

7. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4,039,559 and US Pat. Appl. No. 2002/0068102 A1 (effective filing date December 1, 2000) for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that US '559 does not teach using *M. citrifolia* to treat liver damage and that US '102 does not teach using the specific concentrations of *M. citrifolia* to treat liver damage. However, the references taken together teach using *M. citrifolia* to treat liver damage because US '559 teaches that carbon tetrachloride causes liver damage due to its ability to produce harmful free radicals and US '102 teaches that *M. citrifolia* is an antioxidant. In addition, US '102 teaches that effective amounts of *M. citrifolia* are based

Art Unit: 1654

at 1 ounce and can vary up or down in dosage depending on the desire of the artisan (see paragraph [0043]). Therefore, the amounts used by US '102 are close to the amounts claimed by applicant.

8. No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

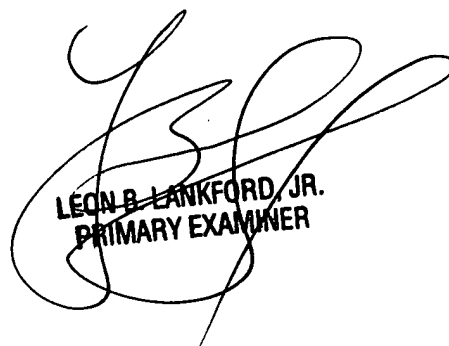
Application/Control Number: 10/036,152

Page 6

Art Unit: 1654

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner  
September 22, 2003



LEON B. LANKFORD, JR.  
PRIMARY EXAMINER